

## **II. REMARKS**

In the Office Action, the Examiner indicated that claims 4, 7-12, 20-24, 26-32, 34, 39, 41 and 42 were objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicants have amended claim 1 without prejudice to incorporated the limitations of claim 4. In addition, Applicants have amended claims 19 and 38 without prejudice to also include the limitations of claim 4. Claims 4 and 37 have been cancelled without prejudice. New claims 52-57 have been added. Support for the new claims can be found in the original claims and throughout the specification.

Claims 1, 5-34, and 38-57 are pending in this application.

### **A. Rejections Under 35 U.S.C. Section 102**

#### **1. Trinh et al.**

In the Office Action dated September 22, 2004, the Examiner rejected claims 1, 5, 6, 13-19, 25 and 33 “as being anticipated by Trinh et al. (U.S. 5,540,853). The Examiner asserted that “[c]laim 1 is a broad composition that comprises a matrix and the matrix comprises an emulsion and the emulsion contains at least one therapeutic agent and at least one cross-linked polymer, where the therapeutic agent and the polymer are in the aqueous phase. An emulsion is understood by the person of ordinary skill in to contain oil and water phases. A ‘matrix capable of delivering at least one therapeutic agent to a bodily compartment under controlled release conditions’ as recited in generic claim 1 is a property of the compositions and is not accorded any patentable weight. Claims 15 and 16 are directed to the inherent property of the composition.” The Examiner stated that “Trinh meet the limitation of the claims.”

This rejection is traversed. In view of the amendments to claims 1, incorporating the limitations of claim 4, it is respectfully submitted that the rejection of independent claim 1 and those claims which depend from claim 1 is now moot. With respect to

independent claim 19, which has also been amended to incorporate the limitations of claim 4, it is respectfully submitted that Trinh et al. fail to teach the method of preparing a pharmaceutically composition as recited in present claim 19.

Therefore, the Examiner is respectfully requested to remove the 35 U.S.C. §102 rejection of claims 1, 5, 6, 13-19, 25 and 33.

**2. Yanaki et al.**

Claims 37, 38, 40 and 43-51 were rejected under 35 U.S.C. 102(b) “as being anticipated by Yanaki et al. (U.S. 5,538,728).” The Examiner stated that “Yanaki meets the limitations of the claims.”

This rejection is traversed. Independent claim 37 has been cancelled without prejudice. Independent claim 1 has been amended to include the language of claim 4 as well as certain language from claim 1. It is respectfully submitted that Yanaki et al. fail to teach a controlled release composition as recited in present claim 38.

Therefore, the Examiner is respectfully requested to remove the 35 U.S.C. §102 rejection of claims 37, 38, 40, and 43-51.

**B. Revocation and appointment of New Power**

The Examiner’s attention is further directed to the two Revocation of Power of Attorney and Appointment of New Power of Attorney Forms and Two Statements under 37 CFR 3.73(b) submitted herewith.


### **III. CONCLUSION**

In view of the actions taken and arguments presented, it is respectfully submitted that reconsideration of the amended claims and withdrawal of the previous rejection is warranted.

An early allowance is earnestly sought. Should a discussion aid in furthering the prosecution of this application, the Examiner is invited to telephone the undersigned at (212) 736-1940, ext. 101, to effect a resolution.

Respectfully submitted,

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